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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,904	06/26/2003	John McDonough	08575-074001	5680
26161	7590	09/12/2005	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			PWU, JEFFREY C	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/606,904

Applicant(s)

MCDONOUGH ET AL.

Examiner

Jeffrey C. Pwu

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-22 and 42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For a claim to be statutory under 35 USC 101 the following two conditions must be met:

- 1) In the claim, the practical application of an algorithm or idea result in a useful, concrete, tangible result, AND

- 2) The claim provides a limitation in the technological art that enables a useful, concrete, tangible result.

As to the technology requirement, note MPEP Section iV 2(b). Also note In Re Waldbaum, 173USPQ 430 (CCPA 1972) which teaches “useful arts” is synonymous with “technological arts”. In re Musgrave, 167USPQ 280 (CCPA1970), In re Johnston, 183USPQ 172 (CCPA 1974), and In re Toma, 197USPQ 852 (CCPA 1978), all teach a technological requirements. Respect to claim 1, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e. abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance in the technological arts fails to promote the “progress of science and useful arts” (i.e. physical science as opposed to social science or abstract idea, for example) and therefore are found to be non-statutory subject matter. For a method claim to pass muster, the recited method must somehow apply, involve, use, or advance the technological arts. In the instance case, claim 1, only recites an abstract idea. The recited steps of merely displaying a list of vaguely defined potential other entities, receiving information from one entity to another entity and abstract display of potential other entities with whom the user may [or may not] have account does not apply, involve, or advance the technical arts.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure lacks clear written description in the description of how to determine a list of one or more other entities that provide network-accessible account being performed automatically, by a first entity or other entities. The disclosure also lacks description how to determine an undefined "potential other entities".

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 23, and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 23, and 41 are vague and indefinite because it is unclear how to automatically determining a list of one or more other entities that provide network-accessible accounts.

7. Claims 1, 23, and 41 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. It is unclear how to automatically determine a list of one or more other entities that provide network-accessible accounts.

8. Claim 1, 23, and 41 recites the limitation "other entities". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-43 are rejected under 35 U.S.C. 102(e) as being unpatentable by Sheth et al. (US 2002/0194502).

Sheth et al. disclose a system and method comprising:

automatically determining, by a first entity (a grantor) and using data associated with a user, a list of one or more other entities that provide network-accessible accounts (Host Server 1010);

receiving from the user at least one a second entity selected from the list of one or more other entities (paragraph [0020]; “Using the visitation access codes to selectively grant visitation access to one or more of the grantor’s view pages to one or more of the grantees...”); and

receiving from the user access information for at least one network-accessible account that is provided by the at least one selected second entity (paragraph [0020]; also see related “access code”).

wherein determining the list further comprises determining personalization data associated with the user (paragraph [0019]-[0022], hereinafter [0019]-[0022]).

wherein the personalization data includes a characteristic shared by a pre-defined group of users ([0019]-[0022]).

wherein the characteristic comprises one of a geographical location, a type of computer, a type of operating system, a pattern of web navigation, and an amount of money in a financial account ([0019]-[0022]; [0045]-0058]).

wherein determining the personalization data further comprises: providing a personalization test to the user; and analyzing one or more answers of the user from the personalization test (paragraph [0045]-0058]).

wherein determining the personalization data further comprises automatically collecting a characteristic associated with the user ([0045]-[0058]).

wherein enabling the user to select a second entity further comprises displaying the list of one or more entities to the user ([0052]).

wherein determining further comprises determining one or more entities that have a relation to the first entity (paragraph [0020]; “Using the visitation access codes to

selectively grant visitation access to one or more of the grantor's view pages to one or more of the grantees...").

wherein determining one or more entities that have a relation to the first entity further comprises: identifying the one or more entities that have the relation to the first entity; and ordering the list based on the relation ([0020]).

wherein the relation comprises competition ([0396]).

wherein the relation comprises a partnership ([0396]).

wherein the access information comprises: a user identifier for the account; and an account authenticator ([0100]).

wherein the access information for the network-accessible account makes the network-accessible account automatically accessible over a network (abstract).

wherein the data about the user comprises at least one of a name, a geographic location, a computer system used by the user, and a history of web-navigation ([0100]).

wherein the data associated with the user comprises information about the accounts provided by the first entity ([0086]).

wherein the information comprises a balance of a first account provided by the first entity ([0138]).

adding the network-accessible account to an aggregation of accounts ([0388], [0203], [0360]).

enabling the user to select a first account provided by the first entity; and adding the first

account to the aggregation of accounts ([0388], [0203], [0360]).

wherein the first entity comprises a financial institution, the method further comprising providing, by the first entity, one or more financial accounts to the user ([0392]).

wherein enabling the user to select a second entity further comprises enabling the user to select a second entity comprising a financial institution from the list of one or more entities that provide financial accounts (second grantor).

wherein enabling the user to select a second entity further comprises enabling the user to select a second entity from the list of one or more entities that provide email accounts, frequent flier accounts, or calendar accounts (paragraph [0020]).

Response to Arguments

11. Applicant's arguments filed 6/7/2005 have been fully considered but they are not persuasive.

With respect to applicant's argument that Sheth does not describe that "the entity through which the user has network access can automatically determine a list, using data associated with the user, of one or more other entities from which the user can select at least one second entity the user wishes to access".

Firstly, in the independent claims, applicant fails to disclose how to automatically determining a list of one or more other entities that provide network-accessible accounts in the claim.

Secondly, examiner is confused on how to determine a list of potential other entities when "potential other entities" is undefined and how to determine the list of a likely potential institutions when the "likely potential institutions" are undefined.

"Potential other entities" and "likely potential institutions" are considered hypothetical abstract idea.

In contrast, Sheth discloses a concrete, tangible, and useful system/method that the entity through which the user has network access can automatically determine a list, using data associated with the user, of one or more other entities from which the user can select at least one second entity the user's access. (see paragraph [0019]-[0022])

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Pwu whose telephone number is 571 272-6798. The examiner can normally be reached on 7:45-6:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



March 3, 2005

JEFFREY PWU
PRIMARY EXAMINER